

REMARKS

Applicant has carefully reviewed and considered the Examiner's Office Action dated June 20, 2005. Reconsideration is respectfully requested in view of the foregoing amendments and the following comments.

By this Amendment, claims 1 and 5 are amended adopting the Examiner's suggestions. In particular, the independent claims are amended to positively recite the implicitly claimed structure of "teeth arranged opposite each other on opposing sides of the carrier relative to the pivot" (page 2, paragraph [0007] of the specification) and to recite that the notches are formed along the book block spine in the body of the claims thereby repeating the preamble statement in the body of the claims. Claims 1-9 are pending in the present application with claims 4 and 7-8 withdrawn as being elected to a non-elected species.

Claims 1-3, 5-6 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated U.S. Patent No. 4,408,780 to Detterman *et. al.* (hereinafter referred to as "Detterman") as explained in paragraph 3 of the Action. This rejection is respectfully traversed.

Detterman is directed to a method of making bound books where the notches 29 are formed of cutters of a different structure than claimed by Applicant and, as a result, produce notches 29 with "clean, straight faces" instead of arc-shaped notches as claimed by Applicant. See column 3, lines 4-17 and Figures 1, 4, and 6 of Detterman. That is, Detterman does not disclose 1) cutting teeth arranged opposite each other on opposing sides of the carrier relative to the pivot and are oriented at an acute angle β to the circular cutting plane and 2) the teeth cutting into the book block spine to produce arc-shaped notches along the spine of the book block.

It is the Action's position that Detterman's cutting teeth are on opposite sides of the carrier. However, Detterman does not disclose or illustrate cutting teeth arranged opposite one another on opposing sides of the carrier as claims 1 and 5 have been amended to conform with the specification and the Examiner's comments. Detterman discloses three sets 52 of notching blades, which extend upwardly from plate 51. The sets are disclosed as evenly spaced about the periphery of the plate (column 4, lines 51-53 of Detterman). That is, the blades are not arranged opposite to other blades. Figure 8 clearly shows that the three sets are evenly spaced in different sectors that are arranged opposite a non-blade section.

As a result of the oppositely arranged cutting teeth, the claimed invention produces an arc-shaped notching pattern as shown in Figure 3. This arc-shaped notching pattern improves the rigidity and clamping effect of a book block spine. Contrary to the Action's assertion that Detterman "intrinsically makes accurate cuts" is countered by the actual disclosure of Detterman. The arrangement disclosed by Detterman produces notches 29 with "clean, straight faces" (Column 3, lines 16-17 of Detterman). Detterman emphasizes that the disclosed arrangement have right-hand faces 31 and left-hand faces 32, which are clearly show as cutting straight through all of the signatures. There is no disclosure of producing an arc-shaped notch in Detterman and the same cannot be considered inherent because Detterman specifically points out that notches are produced with "clean, straight faces" and illustrates linear notches 29 (column 3, lines 29-31 and Figures 1, 4, and 6 of Detterman. Consequently, Detterman does not positively disclose each and every claimed feature, nor does Detterman inherently disclose the claimed arc-

shaped notch feature. Consequently, claims 1-3, 5-6 and 9 are not anticipated by Detterman. Withdrawal of this rejection is respectfully requested.

Claims 1-3 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated U.S. Patent No. 296,757 to Kraushaar as explained in paragraph 4 of the Action. This rejection is respectfully traversed.

As the Action acknowledges, Kraushaar does not disclose notching books. Anticipation requires that every limitation of the claim in issue be disclosed either expressly or under principles of inherency in a single prior art reference. The Board of Patent Appeals and Interferences does not overrule Federal Circuit decisions and those of their predecessor (CCPA) which hold that the single prior art reference must be capable of inherently possessing the functional characteristic relied upon. *In re Robertson*, 169 F.3d 743, 48 USPQ2d 1949 (Fed. Cir. 1999); *In re Schreiber* 128 F.3d 1473, 44 USPQ2d 1439 (Fed. Cir. 1997); *Corning Glass Works v. Sunitomo Electric U.S.A* 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989); *In re Hallman*, 655 F.2d 212, 210 USPQ 609 (CCPA 1981); and *In re Swinehart et al.*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

The structure of Kraushaar is not capable of inherently possessing the feature, “teeth cutting into a book block spine to produce arc-shaped notches along the spine of the book block”, as the receptacle *a* of Kraushaar would not allow a book block to be conveyed along a path for a perfect binder as set forth in the preamble and later stated in the body of the claim. Thus, as the Action recognizes, amending the body of independent claims 1 and 5 to recite “to produce arc-shaped notches along the spine of the book” would overcome this vegetable slicer rejection. As stated above, claims 1 and 5 are amended to recite the above language in the body of the claim. Consequently, claims 1-3

and 9 are not anticipated by Kraushaar. Withdrawal of this rejection is respectfully requested.

Claims 5-6 were rejected under 35 U.S.C. §102(b) as being anticipated U.S. Patent No. 3,758,928 to Blake as explained in paragraph 5 of the Action. This rejection is respectfully traversed.

Blake is directed to a tool for use in book binding where a book 12 passes across plate 17. However, shaft 15 of plate 17 is parallel to the conveying path of book 12, as shown in Figure 3 of Blake. Thus, Blake does not disclose the wherein clause in that last two lines of claim 5. Consequently, Blake does not positively disclose each and every claimed feature and cannot anticipate claims 5 and 6. Withdrawal of this rejection is respectfully submitted.

With respect to the Examiner's comment concerning the claim language "approximately perpendicular", the claim language does not require that the pivot is perpendicular to the book block spine, but approximately perpendicularly as shown in Figure 1. Thus, the elected species and the last lines of Figure 5 are consistent with the recitation of "approximately perpendicular".

For the above stated reasons, it is submitted that all of the elected claims, i.e., claims 1-3, 5-6 and 9, are allowable over the prior art of record and are in condition for allowance. Therefore, it is respectfully submitted that this Amendment After Final Rejection places the application in condition for allowance; does not raise new issues that require further consideration and/or search as the changes to claims 1 and 5 adopt the Examiner's suggestions; and do not raise the issue of new matter. Accordingly,

Applicant respectfully request that this Amendment After Final Rejection be entered, that non-elected claims 4 and 7-8 be rejoined, and that this application be passed to issuance.

Should the Examiner believe that a conference would advance the prosecution of this application, he is encouraged to telephone the undersigned counsel to arrange such a conference.

Respectfully submitted,



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